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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/954,443	09/17/2001	James Robert Adair JR.	17244-0129	6585

29052 7590 12/01/2005

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EXAMINER	
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ART UNIT	PAPER NUMBER
3721	

DATE MAILED: 12/01/2005

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/954,443
Filing Date: September 17, 2001
Appellant(s): ADAIR ET AL.

Peter G. Pappas
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed November 14, 2005 appealing from the Office action mailed March 3, 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

Claims 9, 12-18 and 21-26 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Eisenstadt (3,228,170) in view of Nakamura (6,301,859).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

3,228,170	M. Eisenstadt	1-1966
6,301,859	Nakamura et al.	10-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 9, 12-18 and 21-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eisenstadt (3,228,170) in view of Nakamura (6,301,859).

Eisenstadt discloses a method and a system for making portion control sized packaged flowable liquid-contianing condiment comprising:

a heat sealable material feeder 23;

a flowable material feeder 101 for feeding a flowable liquid-containing condiment 27; and

a form/fill/seal apparatus structured and arranged for receiving the heat sealable material, forming a portion control sized package with the heat sealable material, filing the portion control sized package with the fowable liquid-containing condiment, and sealing the portion control sized package, the form/fill/seal apparatus including a heat seal die comprising (figures 7 and 15a-e):

a first die member 64 having a longitudinal axis and a die face;

a second die member 64 having a longitudinal axis and a die face;

a first heating element 65, 66 engaged with the first die member for heating the first die member;

a second heating element 65, 66 engaged with the second die member for heating the second die member;

Eisenstadt discloses the claimed invention, but does not expressly disclose the heat seal die that has first and second longitudinal heat tube.

Nakamura discloses (figures 11A & 11B) a heat seal die comprising:

a first and second die members 15 having longitudinal axis and die face;

a first and second heating elements 24;

a first and second longitudinal heat tubes 26 (a & b) disposed in the first and second die member between the heating element and the die face for maintaining a uniform heat seal temperature along the die face.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to modify Eisenstadt's system and method by incorporating the heat seal die as taught by Nakamura providing an improved heat sealer effective to accomplish a uniform and proper temperature distribution in the seal contact faces to secure a high sealing strength in the resultant seal.

Nakamura further discloses the longitudinal heat tube extends from the one end to the other end of the die member; and the heating element 24 is a heating cartridge disposed in a longitudinal bore 23 (a & b) in the die member; the die face of the first die member 15 has plurality of alternating longitudinal lands and grooves 19 and the second die member 15 has plurality of alternating longitudinal lands and grooves 19, the lands and grooves of the first and second die members are arranged for selective mating arrangement; the die member each has longitudinal sides and a raised portion

and sloping walls; and the die member each has a temperature sensor 28 disposed in the downwardly facing longitudinal side.

As discussed above Eisenstadt discloses the claimed invention, but does not expressly disclose that the portion size is in the range from 1 to 5 ounces. However, Eisenstadt discloses that one of the object of the invention "is to provide an automatic packaging machine having a high rate of output and which can be operated without interruption by making simple adjustments for changing the size of packages produced in dimension and quantity of matter within the package" (column 1, lines 27-32).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to produce packages of portion size in the range of one desire (range from 1 to 5 ounces), since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

(10) Response to Argument

In response to the Appellant's argument that:

"... the Eisenstadt patent and the Nakamura Patent do not establish a prima facie case of obviousness under §103 because the Nakamura Patent expressly teaches away from using heat tubes in heat sealing dies (see col. 9, 1.44 - col. 10, 1. 27) such that there is no motivation to modify the teaching of the Eisenstadt patent to use heat tubes in the manufacture of portion control sized packaged condiments and there is no reasonable expectation of success in doing so." (page 7, lines 2-7),

the examiner respectfully disagrees.

Nakamura Patent does not teach away from using the heat tubes. Nakamura shows in figure 11A, a prior art, in which the heat tubes (26a, 26b) are used in the heat-sealing jaws (15), and Nakamura discloses that:

"... the heat pipes employed in the prior art transverse heat-sealing jaw are of a design wherein a wick is filled to an inner peripheral surface of each heat pipes ... This design utilizes the phase change of the working liquid which is vaporized when heated, but returns to a liquid phase when cooled in contact with a portion of the respective heat pipe where the temperature is low, so that heat can be quickly and efficiently transmitted in the lengthwise direction of the respective heat pipe." (column 10, lines 1-10) (emphasis added).

The teaching from the prior art (figure 11A) of Nakamura is the only teaching that the examiner relied upon for the 103 rejection, because it shows that it is old and well known in the art to use the heat pipe to provide a uniform heating surface in the lengthwise direction of the heat-sealing jaw.

Although Nakamura further discloses that:

"However, as a result of a series of experiment conducted by the inventors of the present invention, it has been found that the heat pipe has not sufficient heat conductive characteristic in a radial direction, and that the use of the heat conducting members having a high heat conductivity λ such as employed in the practice of the present invention has exhibited an excellent heat conductive characteristic in a radial direction and, also, a sufficient heat conductive characteristic in a lengthwise direction although somewhat lower than that exhibited by the heat pipes." (column 10, lines 10-20) (emphasis added).

Nakamura, in this disclosure, simply emphasizes that the heat pipe is a better choice for heating the heat-sealing jaws in the lengthwise direction, but for the heating of the heat-sealing jaws in the radial direction, the heat conducting member (other than the heat pipe) such as the one discloses in the Nakamura present invention is more suitable.

In response to Appellant's argument that:

"The Eisenstadt patent does not disclose any detail regarding the structure of the heat sealing jaws or the manner of heating them" (page 7, lines 19-20) and *"The Nakamura Patent teaches conventional form/fill/seal packaging and does not relate to what is known in the industry as portion control size packaging of condiments." (page 8, lines 3-4).*

the examiner would like to drawn the Appellant's attention to the MPEP § 2145:
IV. ARGUING AGAINST REFERENCES INDIVIDUALLY
One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., Inc., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to Appellant's argument that:

"The technology of claims 9 and 18 encompasses a preferred embodiment wherein multi-lane portion control packaging machinery system makes many (equal to the number of lanes) pouches with each cycle of product delivery. This multi-lane, multi-pouch production cycle efficiently produces portion control condiments. The subject matter of claims 9 and 18 provides consistent seal integrity across multiple lanes of this machinery. In contrast, the Nakamura Patent teaches that heat tubes do not adequately maintain an acceptable longitudinal temperature variation (i.e. in the direction "X" as indicated in Figure 1A) for heat-seal jaws (column 9., lines 44-67). In fact, multi-lane portion control packaging machinery has heat-seal jaws with much less depth (Dimension "Y" in Figure 1b) than the packaging machinery described in the Nakamlzra Patent. First Cigallio Declaration, ¶ 16." (page 10, lines 10)(emphasis added).

Appellant misinterprets the principle that claims are interpreted in the light of the specification. Although these elements such as "multi-lane", "multi pouch production", "consistent seal integrity across multiple lane", and "multi-lane portion control packaging machinery" are found as examples or embodiments in the specification, they were not claimed explicitly. Nor were the words that are used in the claims defined in the specification to require these limitations. A reading of the specification provides no evidence to indicate that these limitations must be imported into the claims to give meaning to disputed terms. *Constant v. Advanced Micro-Devices, Inc.*, 7 USPQ2d 1064.

In response to Appellant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning:

"Combination of the Nakamura patent with the Eisenstadt patent is mere hindsight reconstruction. Although patent examination is necessarily conducted after an invention is made "the combination of elements from non-analogous sources in a manner that reconstructs the Applicant's invention only with the benefit of hindsight is insufficient to present a prima facie case of obviousness." In re Oetiker, 977 F.2d at 1445-1447 24 USPQ 2nd at 1446 (Fed. Cir. 1992).
The criteria of prima facie obviousness are therefore not met by the combination of the Eisenstadt and Nakamtlra Patents." (page 11, lines 12-17) (emphasis added),

the examiner respectfully disagrees.

First of all, the Appellant has admitted on page 10 (line 21) that: "Applicants are not arguing that the Nakamura patent is non-analogous art.".

Secondly, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

The Declarations under 37 CFR 1.132 of Richard Vincent Dougherty and Edward Joseph Cigallio are carefully considered, but are not found persuasive because they are insufficient to overcome the rejection of claims 9, 12-18 and 21-26 based upon Eisenstadt and Nakamura references applied under 35 U.S.C. 103 set forth in the Office action (August 24, 2005). The facts presented are not germane to the rejection at issue

and the Declarations are mere repeating of the arguments in which the examiner has responded in paragraphs above (in the section (10) Response to Argument).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

tkt
November 27, 2005.

Conferees:
John Sipos
Louis Huynh
Thanh Truong

Stephen F. Gerrity
Primary Examiner